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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
WON, MICHAEL YOUNG	

ART UNIT	PAPER NUMBER
2155	

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/668,875	FREESTONE ET AL.	
	Examiner	Art Unit	
	Michael Y. Won	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 October 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-45* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to the Decision on Petition Under 37 C.F.R 1.137(b) filed October 3, 2005 and responsive to the Amendment filed October 25, 2004.

2. Claims 1, 8, and 24 have been amended.

3. Claims 1-45 have been examined and are pending with this action.

Claim Rejections - 35 USC § 112

4. Claims 1, 8, and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The recited page 4, lines 17-18 do not support the presently amended claim. Lines 16-18 on page 4 of the specification states:

Once the message is downloaded, the recipient's computer may note the existence of the e-mail's predetermined identifier, and if the correct feature is present and enabled, the computer automatically opens and plays the sound file.

The applicant assumes that because the recipient's computer recognizes the existence of a predetermined identifier, that such identifier indicates a course of action to be taken on the file. The "course of action to be taken" expresses within the claim limitation that more than one action is considered. However, the above-recited lines only indicate that when the recipient's computer recognizes the existence of a correct identifier, "the computer automatically opens and plays the sound file". There is insufficient evidence that the identifier indicates a course of action but rather triggers a reaction or a response (namely a pre-established action). In other words, depending on whether the identifier is correct or not determines whether the computer opens and plays or not. The claim language should be corrected to reflect such teachings.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-10, 12-19, 21-31, 33-41, and 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al. (US 5,732,216 A) in view of Palmer et al. (US 6,259,444 B1).

INDEPENDENT:

As per ***claim 1***, Logan teaches an electronic message comprising: sound file (see col.42, line 67 to col.43, line 2); and, predetermined identifier with said sound file (see col.15, lines 15-19; col.44, lines 12-15; and col.45, lines 52-54).

Logan does not explicitly teach wherein the identifier indicates a course of action to be taken with the file. Palmer teaches of an identifier indicating a course of action to be taken with the file (see col.16, lines 18-31 & lines 44-51).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Palmer within the system of Logan by implementing an identifier indicating a course of action to be taken within the electronic messaging system because Palmer teaches that in a file system users are allowed to create, edit, and manipulate "the content and structure of the file system" (see col.4, lines 17-22), therefore, regardless of the type of file system, implementing the teachings of Palmer would allow the user to create, edit, and manipulate the sound or audio content and sound or audio structure.

As per ***claim 8***, Logan teaches a method for sending an e-mail comprising: attaching a sound file to an e-mail (see col.42, line 67 to col.43, line 2); and utilizing a predetermined identifier with said sound file into said email (see col.15, lines 15-19; col.44, lines 12-15; and col.45, lines 52-54).

Logan does not explicitly teach wherein the identifier indicates a course of action to be taken with the file. Palmer teaches of an identifier indicating a course of action to be taken with the file (see col.16, lines 18-31 & lines 44-51).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Palmer within the system of Logan by implementing an identifier indicating a course of action to be taken within the method for sending an e-mail because Palmer teaches that in a file system users are allowed to create, edit, and manipulate "the content and structure of the file system" (see col.4, lines 17-22), therefore, regardless of the type of file system, implementing the teachings of Palmer would allow the user to create, edit, and manipulate the sound or audio content and sound or audio structure.

As per ***claim 24***, Logan teaches a method for announcing electronic messages comprising: receiving an electronic message with an attached sound file (see col.42, line 67 to col.43, line 2); noting the presence of a predetermined identifier with said sound file (see col.15, lines 15-19; col.44, lines 12-15; and col.45, lines 52-54); and, playing the attached sound file (see col.1, lines 42-46).

Logan does not explicitly teach wherein the identifier indicates a course of action to be taken with the file. Palmer teaches of an identifier indicating a course of action to be taken with the file (see col.16, lines 18-31 & lines 44-51).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Palmer within the system of Logan by implementing an identifier indicating a course of action to be taken within the method for announcing electronic messages because Palmer teaches that in a file system users are allowed to create, edit, and manipulate "the content and structure of the file system" (see col.4, lines 17-22), therefore, regardless of the type of file system, implementing

the teachings of Palmer would allow the user to create, edit, and manipulate the sound or audio content and sound or audio structure such as "playing" the sound file.

DEPENDENT:

As per ***claims 2-4, 14-16, and 26-28***, Logan further teaches wherein said sound file contains at least one word in a computer-simulated voice and at least one word in a sender's voice (see col.28, lines 19-26).

As per ***claim 5***, Logan further teaches wherein the predetermined identifier is a specific file name associated with said sound file (see col.5, lines 6-15).

As per ***claims 6, 17, and 29***, Logan further teaches wherein the predetermined identifier is an information tag (see col.44, lines 12-15).

As per ***claims 7, 18, and 30***, Logan further teaches wherein the information tag is embedded in the e-mail header (see col.43, lines 5-15).

As per ***claim 9***, Logan further teaches wherein said attaching, is performed by a computer at a sending party's end (see col.15, lines 15-19).

As per ***claim 10***, Logan further teaches wherein said attaching is automatic (see col.10, lines 28-36).

As per ***claim 12***, Logan further teaches wherein said attaching, is performed by an e-mail server (see col.4, lines 40-46 and col.6, lines 39-41).

As per ***claim 13***, Logan further teaches wherein said attaching is, performed by a recipient computer (see col.2, lines 10-14 and col.15, lines 15-19).

As per ***claims 19 and 31***, Logan further teaches wherein the information tag, is embedded by a sender computer (see col.43, lines 26-33 & 46-60 and col.44, lines 12-15).

As per ***claims 21 and 33***, Logan further teaches wherein the information tag, is embedded by an e-mail server (see claim 7 and 19 rejection above).

As per ***claim 22 and 34***, Logan further teaches wherein the information tag, is embedded by a recipient computer (see claim 13 and 19 rejection above).

As per ***claim 23***, Logan further teaches wherein said attaching, is selectively performed by a sending party (see col.11, lines 27-34).

As per ***claim 25***, Logan teaches of further comprising receiving at least one more electronic message with an attached sound file and playing said at least one more sound file (see col.7, lines 51-61).

As per ***claim 35***, Logan further teaches wherein said playing is selective (see col.46, lines 26-28).

As per ***claim 36***, Logan further teaches wherein said playing is performed at a recipient computer (see col.1, lines 42-49).

As per ***claim 37***, Logan further teaches wherein said playing is performed at recipient customer premise equipment (see col.1, lines 42-49)

As per ***claim 38***, Logan further teaches where said playing is performed at a recipient voice mail (see col.15, lines 31-46).

As per ***claim 39***, Logan teaches of further comprising converting the content of the electronic message to a voice message (see col.28, lines 19-26).

As per ***claim 40***, Logan further teaches where said converting is performed at an e-mail server (see col.5, lines 26-31).

As per ***claim 41***, Logan further teaches where said converting is performed at a recipient computer (see col.5, lines 16-26).

As per ***claim 44***, Logan further teaches wherein said converting is performed using a sound file as a voice sample.

As per ***claim 45***, Logan teaches of further comprising transferring said voice message to a voice mailbox (see col.15, lines 31-46 and col.29, lines 36-41).

6. Claims 11, 20, 32, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al. (US 5,732,216 A) and Palmer et al. (US 6,259,444 B1), and further in view of Agraharam et al. (US 6,085,231 A).

As per ***claims 11, 20, 32, and 42***, Logan further teaches wherein said attaching is performed by a computer at a sending party's end (see claim 9 rejection above), wherein the information tag is embedded by a computer at a sending party's end (see claim 7 rejection above), and wherein said converting is performed at a computer at the receiving party's end.

Logan and Palmer do not explicitly teach of an adjunct to a sender or a receiver for performing these steps. Agraharam teaches of an adjunct (see col.3, lines 20-29).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Agraharam within the system of Logan and Palmer by implementing adjunct devices or means for performing each function by

means of adjunct devices or servers or the like within the method for sending an e-mail or announcing and electronic message because Agraharam teaches that a subscriber can retrieve both their voice-mail and e-mail messages by accessing only their e-mail (see abstract) and Logan teaches comments could be transmitted via an e-mail as an attachment (see col.42, line 67-col.43, line 2). Therefore, if an attachment of an e-mail was to be retrieved that contained comments/voicemail, one would readily employ an e-mail server that is "part of or adjunct" to the ISP (see Agraharam col.3, lines 20-25).

As per ***claim 43***, Logan and Palmer do not explicitly teach wherein said converting is performed at a voice messaging system. Agraharam teaches wherein said converting is performed at a voice messaging system (see Fig.2, #202 & #206 and col.4, lines 7-17).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Agraharam within the system of Logan and Palmer by implementing conversion to be performed at a voice messaging system within the method for sending an e-mail or announcing and electronic message because Logan teaches of voice messages (see col.29, lines 39) and explains how conversion is preferable at the client station to quickly download text files rather than audio files which are larger thus increasing transmission time (see col.5, lines 16-26).

Response to Arguments

7. Applicant's arguments with respect to claims 1, 8, and 24 have been considered but are moot in view of the new ground(s) of rejection.

In response to the "identifier" of *Logan* et al. (US 5,732,216 A), the newly cited reference *Palmer* et al. (US 6,259,444 B1) teaches such limitations.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, *Logan* teaches, "comment could be transmitted as an audio file attachment to an E-mail message" (see col.42, line 67-col.43, line 1). By implementing such features, sufficient motivations exists to employ the retrieving of "both their voice-mail messages and e-mail messages by accessing only their e-mail system" as noted by the applicant(s) as to the teachings of *Agraharam*.

For the reasons above all dependent claims remain rejected.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y. Won whose telephone number is 571-272-3993. The examiner can normally be reached on M-Th: 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Won

October 5, 2005

SALEH NAJJAR
SUPERVISORY PATENT EXAMINER